



Docket No.: 826.1752

607

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Hiroshi TSUDA, et al.

Serial No. 09/960,300

Group Art Unit: 3627

Confirmation No. 4780

Filed: September 24, 2001

Examiner: Lynda C. Jasmin

For: MERCHANDISE MANAGEMENT METHOD, MERCHANDISE RECOMMENDATION METHOD, AND COMPUTER PROGRAM THEREFOR

**RESPONSE TO RESTRICTION REQUIREMENT
AND REQUEST FOR EXAMINER INTERVIEW**

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Restriction Requirement mailed May 23, 2005, refusing to enter the Amendment filed March 7, 2005. In the Restriction Requirement, the Examiner asserted that the March 7, 2005 Amendment presented

claims ... not readable on the elected invention because the newly presented claims 24-32 are drawn to receiving unwanted product specifiers and consolidating records concerned with unwanted products, further receiving ... experienced-product specifiers and maintaining records based on the experienced-product specifiers, which were not required by the elected invention

(Office Action, page 2, lines 3-7).

No basis for determining the scope of the elected invention was provided in the May 23, 2005 Restriction Requirement. The first action by the Examiner in this application was the Restriction Requirement mailed July 27, 2004. In the July 27, 2004 Restriction Requirement, claims 1-14, 18, 19, 21 and 22 were identified as an invention "drawn to [a] 'Method for managing merchandise owned by a consumer', classified in class 705, subclass 22. In response to this Restriction Requirement, claims 1-14, 18, 19, 21 and 22 were elected on August 26, 2004. Thus, the elected invention is a "Method for managing merchandise owned by a consumer" as defined in original claims 1-14, 18, 19, 21 and 22.

In the March 7, 2005 Amendment, filed in response to the first substantive Office Action (mailed November 5, 2004), all of the pending claims were canceled and claims 24-32 were added. It is submitted that the limitations recited in claims 24-32 are drawn to a "Method for managing merchandise owned by a consumer" and do not recite limitations significantly different from the claims elected on August 26, 2004. It will be assumed that there is no dispute that the limitations recited in claims 24-32 that are not identified in the May 23, 2005 Restriction Requirement are within the scope of the elected invention and therefore, the limitations quoted in the first paragraph of this response will be discussed below.

The first phrase identified in the Restriction requirement, "receiving unwanted product specifiers," is part of the limitation "receiving unwanted product specifiers, each specifying an unwanted product any of the customers does not want anymore" recited on lines 7-8 of claim 24. No explanation was provided regarding why the Examiner believes that this operation does not relate to "managing merchandise owned by a consumer" since there is nothing in the term "an unwanted product" that suggests it is not owned by the customer and the overall scope of the claims suggests that the product might be owned by the customer. Furthermore, claim 14 which was included in the originally elected claims, included the limitation "receiving information designating unnecessary merchandise from a plurality of consumers" (claim 14, lines 3-4). It is submitted that the terms "unwanted product" and "unnecessary merchandise" are sufficiently similar that the difference in wording should not result in claim 24 being outside the scope of the elected invention.

The second phrase identified in the Restriction Requirement, "consolidating ... records concerned with unwanted products" is recited on line 9 of claim 24. It is submitted that this limitation is within the scope of the elected invention, because "consolidating records" relates to "managing" and records concerned with "unwanted products" are within the scope of the elected invention for the reasons discussed in the preceding paragraph.

It is also noted that the final operation recited in claim 24, "presenting a result of said consolidating to potential buyers" is almost identical to the final limitation in claim 14, "presenting a collection result to a buyer." Since claim 14 was included in the claims elected August 26, 2004, it is submitted that claim 24 is within the scope of the elected invention.

Claims 25-27 and 32 recite limitations similar to those discussed above with respect to claim 24. Therefore, it is submitted that claims 25-27 and 32 are within the scope of the elected invention for the same reasons discussed above with respect to claim 24.

Claim 28 recites "receiving an unwanted product specifier" at line 8. Instead of reciting "consolidating," claim 28 recites "removing, when the customer does not need to possess any more, the specifier specifying a relevant product being possessed by the customer" (claim 28, lines 10-11). It is submitted that these limitations are within the scope of the elected invention for the reasons discussed above.

None of the phrases quoted above and identified in the Restriction Requirement as causing claims 24-32 to be drawn to a non-elected invention have been found in claim 29 and nothing has been found in claim 29 that seems to be related to the phrases quoted above. . Therefore, it is unclear why the Examiner indicated that claim 29 is not drawn to the elected invention.

Claim 30 recites the third phrase identified in the Restriction Requirement, in the limitations "receiving an experienced-product specifier, identifying a second product the customer has used, but does not possess" (claim 30, lines 7-8), and "maintaining a second record ... based on the experienced-product specifier" (claim 30, last 2 lines). However, elected claim 5 recited "receiving designation of merchandise not owned but ever used by the consumer" (claim 5, lines 3-4). While the meaning of this limitation in claim 5 may not be as clear as the limitation quoted from claim 30, it is clear that the elected invention included information about products not owned by a consumer and therefore is broader than a "Method for managing merchandise owned by a consumer" as defined in the July 27, 2004 Restriction Requirement. Therefore, it is submitted that claim 30 is within the scope of the elected invention.

Claim 31 recites "receiving specifiers of various kinds transmitted from a customer" (claim 31, line 4), including "a fourth product the customer does not need to possess anymore that the customer still possess" (claim 31, lines 12-13) and "a fifth product the customer does not need to possess that the customer has purchased" (claim 31, lines 14-15). There should be no dispute that both the fourth and fifth products are "merchandise owned by a consumer." Furthermore, as discussed previously, the elected claims included limitations related to products not possessed by the consumer, such as those that had been previously used by the consumer. Therefore, it is submitted that transmission of these specifiers is within the scope of the elected invention. The second operation recited in claim 31 is maintaining records based on the information provided by the customer which is within the scope of the elected invention.

Also, it is noted that "removing identified products from a selling-range of products offered to the customer based on the first and third through fifth record types when offering the selling-range of products to the customer" (claim 31, last three lines) is similar to the limitation

recited in elected claim 10, "removing merchandise owned by the consumer from merchandise to be recommended according to information about merchandise owned by the consumer when the recommendation is performed" (claim 10, last four lines). It is submitted that this is substantially similar to the final operation recited in claim 31. Therefore, it is submitted that claim 31 is within the scope of the elected invention.

For the reasons discussed above, it was improper to refuse to consider any of the claims in the March 7, 2005 Amendment. If it is necessary to issue a Restriction Requirement, because some of the claims in the March 7, 2005 Amendment are not deemed to be directed to the elected invention, then the Restriction Requirement should be reissued identifying those claims.

REQUEST FOR EXAMINER INTERVIEW

If this Response does not persuade the Examiner that the March 7, 2005 Amendment should be entered and examined as containing claims directed to the invention elected on August 26, 2004, the Examiner is respectfully requested to contact the undersigned by telephone to arrange an Examiner Interview for the purpose of discussing what changes in claim language are necessary to obtain examination of the claims.

If there are any additional fees associated with filing of this Response, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 6/23/05

By: Richard A. Gollhofer
Richard A. Gollhofer
Registration No. 31,106

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501

CERTIFICATE UNDER 37 CFR 1.8(a)
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
on 6/23/2005
STAAS & HALSEY Richard A. Gollhofer
By: Richard A. Gollhofer
Date: 6/23/05